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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,960	11/27/2001	Koji Tokunaga	15124	1702

23389 7590 10/18/2006

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EXAMINER

PHUONG, DAI

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/994,960	Applicant(s) TOKUNAGA, KOJI	
	Examiner Dai A. Phuong	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/06/2006 has been entered.

Response to Amendment

2. Applicant's arguments, filed 09/06/2006, with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Claims 1-3 are currently pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 are rejected under 35 U.S.C. 101 because claim 1 recites “a plurality of memories, each of which is for endless-recording.” It should be noted that a memory is contained a number of bytes or the memory is not able to store an unlimited of data (endless recording). Therefore, the memory is not able to be an endless-recording memory.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is unclear that the second memory is endless-records the current conversation or the second memory records the current conversation (please see the last three lines of claim 1).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanpei et al. (U.S. 5732349) in view of Minakata et al. (U.S. 6658496) and further in view of Qua et al. (U.S. 6222909).

Regarding claim 1, Sanpei et al. disclose a portable phone having a recording function for recording audio data during telephone conversation (fig. 3, col. 5, lines 1-14), said portable phone comprising: a memory 24 which is for endless recording, as a conversation content, the audio data during the telephone conversation (fig. 3, col. 5, lines 1-14).

However, Sanpei et al. do not disclose a plurality of memories, each of which is for endless recording, as a conversation content, the audio data during the telephone conversation; a switching unit capable of switching said memories from a first memory of said memories to a second memory of said memories so that said second memory endless-records the audio data instead of said first memory which endless-records, as the conversation content, the audio data until said switching unit switches said memories from said first memory to said second memory; and a reproducing unit for reproducing the conversation content which said first memory endless-records before being switched by said switching unit, while the second memory endless-records the current conversation simultaneously with the reproducing of the conversation content from the said first memory.

In the same field of endeavor, Minakata et al. disclose a plurality of memories 9a and 9b, each of which is for endless recording, as a conversation content, the audio data during the telephone conversation (fig. 1, col. 2 lines 53-67); a switching unit 50 capable of switching said memories from a first memory of said memories to a second memory of said memories so that said second memory endless-records the audio data instead of said first memory which endless-records, as the conversation content, the audio data until said switching unit switches said memories from said first memory to said second memory (col. 3, lines 32-51); and a reproducing unit 20 for reproducing the conversation content which said first memory endless-records before being switched by said switching unit, while the second memory endless-records the current conversation (fig. 1, col. 4, line 47 to col. 5, line 11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the telephone of Sanpei et al. by specifically including a plurality

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of memories, each of which is for endless recording, as a conversation content, the audio data during the telephone conversation; a switching unit capable of switching said memories from a first memory of said memories to a second memory of said memories so that said second memory endless-records the audio data instead of said first memory which endless-records, as the conversation content, the audio data until said switching unit switches said memories from said first memory to said second memory; and a reproducing unit for reproducing the conversation content which said first memory endless-records before being switched by said switching unit, while the second memory endless-records the current conversation., as taught by Minakata et al., the motivation being in order to provide a recording/reproducing apparatus in which it is possible to improve tractability of a recording/reproducing apparatus having plural storage units, such as removable storage units, and to facilitate the operation of transfer processing for data stored in a storage unit of the recording/reproducing apparatus.

In the same field of endeavor, Qua et al. disclose a reproducing unit for reproducing the conversation content which said memory endless-records before being switched by said switching unit, while the memory endless-records the current conversation simultaneously with the reproducing of the conversation content from the said first memory (col. 1, lines 40-49 and col. 6, line 39 to co. 8, line 13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the telephone of Sanpei et al. by specifically including a reproducing unit for reproducing the conversation content which said memory endless-records before being switched by said switching unit, while the memory endless-records the current conversation simultaneously with the reproducing of the conversation content from the said first

memory, as taught by Qua et al., the motivation being in order to distribute the stored information to oneself or other parties once the information has been recorded. On the other hand, it provides a user ability to take accurate note while engaged in a conversation, since the user may simultaneously be engaged in another task.

Regarding claim 2, the combination of Sanpei et al. and Minakata et al. and Qua et al. disclose all the limitations in claim 1. Further, Minakata et al. disclose a portable phone wherein said memories are constituted by a plurality of memory areas of a single memory device, said memory areas being capable of individually endless-recording the audio data (col. 5, lines 64 to col. 6, line 12).

Regarding claim 3, the combination of Sanpei et al. and Minakata et al. and Qua et al. disclose all the limitations in claim 1. Further, Minakata et al. disclose a portable phone further comprising a key for operating said reproducing unit to reproduce the audio data; said reproducing unit successively reproducing the conversation contents in the order of recording in which said memories records the conversation contents (fig. 1, col. 4, line 47 to col. 5, line 11).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dai A Phuong whose telephone number is 571-272-7896. The examiner can normally be reached on Monday to Friday, 9:00 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nguyen M Duc can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-7503.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dai Phuong

AU: 2617

Date: 10-02-2006



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